

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 25

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOSEPH F. BALL

Appeal No. 95-4806
Application No. 08/155,730¹

HEARD: January 11, 1999

Before ABRAMS, STAAB and McQUADE, *Administrative Patent Judges*.

ABRAMS, *Administrative Patent Judge*.

¹ Application for patent filed November 22, 1993. According to appellant, this application is a continuation of Application 07/847,662 filed March 5, 1992, now U.S. Patent No. 5,310,056 issued May 10, 1994; which is a continuation of Application 07/809,048 filed December 16, 1991, now U.S. Patent No. 5,174,449 issued December 29, 1992; which is a continuation-in-part of Application 07/593,335 filed October 1, 1990, now abandoned; which is a continuation of Application 06/864,026 filed May 16, 1986, now abandoned.

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DECISION ON APPEAL

This is an appeal from the decision of the examiner finally rejecting claims 47-54, which constitute all of the claims presently pending in the application.

The appellant's invention is directed to an improved packaging material comprising a plastic web of preopened bags interconnected in end-to-end relationship.

The subject matter before us on appeal is illustrated by reference to claim 47, which has been reproduced in an appendix to the Brief.

THE REFERENCES

The references relied upon by the examiner to support the final rejection are:

Lerner	3,254,828	Jun. 7,
1966		
Benoit	4,597,494	Jul. 1,
1986		

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THE REJECTION²

Claims 47-54 stand rejected under 35 U.S.C. § 103 as being unpatentable over Lerner in view of Benoit.

The rejection is explained in the Examiner's Answer.

The opposing viewpoints of the appellant are set forth in the Brief.

OPINION

In reaching our decision on the issues raised in this appeal, we have carefully assessed the claims, the prior art applied against the claims, and the respective views of the examiner and the appellant as set forth in the Answer and the Brief.

In evaluating the examiner's rejection, the basic guidance provided by our reviewing court is that in rejections under 35 U.S.C. § 103 the examiner bears the initial burden of presenting a *prima facie* case of obviousness (see *In re Rijckaert*, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir.

² A double patenting rejection was overcome by the filing of a terminal disclaimer (Paper No. 6), and a second rejection under Section 103 was withdrawn (Paper No. 12).

1993)), which is established when the teachings of the prior art itself would appear to have suggested the claimed subject matter to one of ordinary skill in the art (see *In re Bell*, 991 F.2d 781, 783, 26 USPQ2d 1529, 1531 (Fed. Cir. 1993)).

The appellant's invention is directed to solving a problem that, according to the evidence presented, remained unsolved in the packaging art for at least twenty-five years (see affidavits of Bernard Lerner, Dana Liebhart and Vincent Lattur). The invention applies to the type of packaging in which an elongated web of preopened³ bags in interconnected end-to-end relationship is conveyed past stations in which an article is placed into each bag, the bag is closed or sealed, and the bags are separated from the web along lateral lines of weakness defining the top and bottom of the bag. In such a system, if the web is conveyed in the direction of the open end of the bags, they would be blown open, which severely

³ A "preopened bag" is one in which an opening has been created by making a slit in one of the two layers of plastic that have been attached together at their edges to form the bag, as is best illustrated in Figures 3 and 4 of the Lerner reference.

complicates the process. For this reason, when the webs are manufactured, they are conveyed in the direction of the closed end of the bags and therefore, when the web is coiled for transport to the user, the closed ends of the bags are oriented inwardly of the coil, with the open ends being outwardly oriented. Removing the bags by unwinding from the outside of the coil at the packaging station caused the open ends to be oriented in the direction of travel which, as explained above, was undesirable. Therefore, it was the practice in the prior art to rewind each coil of bags before use in the packaging operation, so that as the bags were unwound from the outside of the coil they were oriented with the closed end in the direction of travel. This process of rewinding was a slow and complicated one, for there seemingly was no way to avoid moving the web in the direction of the opening in the bags, with the attendant problem of the bags opening. Several techniques were tried over the years to prevent the bags from opening during rewinding, but none were considered to be successful. See Brief, pages 2-5.

The appellant's solution to the problem was not to rewind the coiled web, but to remove the web from the inside of the

coil, wherein the closed ends of the bags would emerge oriented in the direction of travel. The crux of the invention is manifested in claim 47 in the following passages:

e. the web being flattened and wound in a coil having, prior to dispensing, a center opening of a diameter at least as great as the width of the web; and

f. the coiled web being oriented such that as the web is fed along a path of travel from the center opening bags of the web are fed along such path closed end first.

Claim 51 differs only in the manner in which the opening is described:

e. the web being flattened and wound in an annular coil having, prior to dispensing, a center opening from which the web is free to be fed for packaging operations, the opening being sized such that a web comprised of a series of such bags may be fed from the coil center opening to a packaging station without causing premature separation along one or more of such lines of weakness.

The examiner has taken the position that all of the subject matter recited in independent claims 47 and 51 "except for the opening constructed to permit dispensing therefrom" is disclosed in Lerner, but that from Benoit "it was known in the art to dispense bags from a center opening of a coil of bags," and therefore it would have been obvious to provide the coil

of Lerner with the Benoit opening "in order to facilitate rapid and easy handling" (Answer, pages 2 and 3). We are persuaded by the arguments and evidence provided by the appellant, however, that this is not the case.

Lerner discloses the claimed elongated web of preopened plastic bags interconnected in end-to-end relationship and provided with lines of weakness whereby the individual bags can be separated from the web after packaging. As shown in Figure 4, the Lerner web is unwound from the outside of the coil with the closed ends of the bags oriented in the direction of movement. This is illustrative of the *modus operandi* of the prior art, and the creation of the coil illustrated in Lerner first necessitated that the web be rewound from its prior state, that is, the state which is utilized in the appellant's invention. There is no discussion in Lerner with regard to the center opening in the coil, other than to state that it accommodates an axle (column 7). Thus, Lerner fails to disclose or teach the limitations of claims 47 and 51 regarding the size of the center opening and the orientation of the web (subparagraphs e. and f.).

Benoit relates to packaging and dispensing plastic bags that are in an elongated plastic web in interconnected end-to-end relationship. In the background of the invention portion of Benoit there is a discussion of the problem of twist being imparted to bags being removed from the center of a roll, which includes mention of the relationship between the length of the bags and the diameter of the center opening of the coil, and concludes with the statement that "the larger the bag, the more twist it is given during dispensing" (column 3, lines 20 and 21). Benoit then characterizes his invention in the following manner (column 3, lines 25-37):

There is accordingly a need for a method and means for dispensing large center-windable plastic bags with minimum hand manipulation by the user.

A carton for shipping and successively dispensing large plastic bags from a center-windable roll thereof should have as nearly square a configuration, in the dimensions that are perpendicular to the width of the bags, as possible in order to maximize the strength of the carton and its shipping, storing, and dispensing characteristics and convenience. There is consequently a need for a method that can selectively impart such a selected configuration to a roll of center-unwindable plastic bags being packaged into a carton.

It is clear from the foregoing, considered in the light of the explanation of the invention, that the intention of

Benoit is not to dispense bags from a center opening of a coil. The first step in the Benoit process is to coil the bags (Figure 1). However, the coil, as such, then is discarded. As illustrated in Figures 6-8, Benoit compresses the coil to eliminate the center opening (Figure 7), after which it is folded into the "horseshoe" shown in Figure 8. Benoit teaches dispensing the bags from the inside of the package, as shown in Figure 12, at which point the center opening has ceased to exist, for what was the inner surface 63 of the center opening of Figure 6 now has become, by virtue of the compression and folding, a slit 123 through which the bags 124 protrude and are pulled out to be dispensed (Figure 12). This being the case, while the examiner focuses on Benoit's statement that "the larger the inner roll diameter for a given bag size, the less twist is encountered when removing a large bag from the roll by center unwinding" (column 3, lines 64-66), it is our view that Benoit actually is not referring to the diameter of an opening, but to the effective length of the folded slit in the compressed and folded packages of Figure 12 *et al.* Thus, while at one point in the process of forming a dispensing package there exists a coil having a center

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opening, in the Benoit system bags are not dispensed therefrom.

In addition, as the appellant has pointed out, Benoit has no concern for removing the bags from the dispensing package in such a manner as not to break the perforations between successive bags, which is a major consideration in the appellant's system. Benoit is not dispensing bags for further processing, as is the case with the appellant's invention. Benoit's system is geared to providing bags for immediate use, such as garbage or produce bags, which are to be torn from the web as they exit the package. The appellant now has placed in the record copies of the references referred to in the opening lines of Benoit's column 3 to make the point that the field in which the Benoit invention is used differs from that to which the appellant's invention is directed. The appellant asserts, and we agree, that it matters not at all in Benoit that the bags be dispensed from the roll in such a manner as not to break the perforations. In fact, Benoit specifically teaches that the "roll" from which the bags are dispensed is a "horseshoe-folded roll," and that the bag is pulled by the user from an "off-set slot means for grippingly engaging" each

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bag so as to provide "sufficient tension" to tear the bag from the succeeding one along the line of perforations (column 4, line 10 *et seq.*). This differs from the appellant's invention, where such tension is not desired, and is the reason that the appellant's claims contain limitations regarding the size of the coil center opening.

The bags with which the Benoit invention is used are garbage bags, produce bags and the like. Benoit does not state that these are "preopened" bags, nor in our opinion would one of ordinary skill in the art expect them to be. Therefore it would appear to matter not whether it is the top or the bottom of the bags which exit from the package first. This is confirmed by the in fact that no concern for this is evidenced in the Benoit patent.

The factors discussed above lead us to the conclusion that the combined teachings of the two applied references fail to establish a *prima facie* case of obviousness with regard to either of the independent claims for, even when considered in the most favorable light, they fail to disclose or teach two of the limitations contained in each of the independent

claims. First, even considering, *arguendo*, that Benoit teaches dispensing a web of bags from the center opening of a coil, since Benoit is silent as to which end of the bag exits first and Lerner teaches dispensing bags closed end first but from the outside of the coil, we fail to perceive any teaching, suggestion or incentive which would have led the artisan to orient a web of preopened bags in the Benoit coil such that each bag exits the center opening in the coil with the closed end first. Thus the limitation set forth in the final clause of each of claims 47 and 51 is not met. Second, given the fact that neither reference relates the width of the web to the diameter of the center opening of a coil, and neither recognizes the problem of insuring that the bags are not separated by the force of being pulled from the center opening of the core, the requirements recited in each independent claim concerning the size of the opening are not taught. Nor, in our view, would these limitations inherently have been met by combining the teachings of the applied references.

From our perspective, the only suggestion to combine the references is found in the hindsight afforded one who first

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viewed the appellant's disclosure. This, of course, is impermissible as the basis for a rejection. See *In re Fritch*, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992):

The rejection is not sustained.⁴

The decision of the examiner is reversed.

REVERSED

NEAL E. ABRAMS)	
Administrative Patent Judge)	
)	
)	
)	
)	BOARD OF PATENT
LAWRENCE J. STAAB)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES

⁴ We acknowledge that these same claims were evaluated in view of the same references by a panel of this Board in a decision mailed August 31, 1993, with the opposite result having been reached. However, we had the benefit of evidence and arguments presented by the appellant which were not before the previous panel.

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JOHN P. McQUADE)
Administrative Patent Judge)

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